

ESTTA Tracking number: **ESTTA186406**

Filing date: **01/14/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048682
Party	Plaintiff aSmallWorld Ltd.
Correspondence Address	Robert B. Golden Lackebach Siegel LLP One Chase Road , Lackebach Siegel Building Scarsdale, NY 10583 UNITED STATES rgolden@LSLLP.com, nsaraco@LSLLP.com
Submission	Other Motions/Papers
Filer's Name	Robert B. Golden
Filer's e-mail	rgolden@LSLLP.com, nsaraco@LSLLP.com
Signature	/Robert B. Golden/
Date	01/14/2008
Attachments	Notice of Undeliverable Mail.pdf ( 17 pages )(709069 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In re: Registration No.**      **3,137,789**  
**Trademark:**                      **SMALL WORLD NET**  
**International Class:**        **35, 38, 42**  
**Registration Date:**         **September 5, 2006**

ASMAILWORLD LTD.	X	
	:	
	:	
Petitioner,	:	
	:	<b>Cancellation No.: 92048682</b>
v.	:	
	:	
SMALL WORLD NET CORPORATION,	:	
	:	
Registrant.	:	
	X	

**NOTICE OF UNDELIVERABLE MAIL**

Pursuant to the provision of newly amended 37 CFR §§ 2.111 (a) and (b),  
Plaintiff aSmallWorld Ltd. ("Petitioner") by and through its attorneys of record, hereby  
submits this Notice of Undeliverable Mail.

On January 2, 2008, Petitioner, through its undersigned counsel of record, duly  
filed a Petition for Cancellation (the "Petition") at the TTAB and served a copy of the  
Petition on the last known address of Registrant Small World Net Corporation  
("Registrant") as taken from the TARR website of the PTO: 3008 Silverthorn Drive,  
Oakville, Ontario L6L 5N6, Canada. This correspondence was returned as undeliverable  
to Petitioner's attorneys on January 14, 2008. No forwarding address was attached to the  
return envelope. A copy of this correspondence and the returned envelope is enclosed  
herewith as Exhibit A.

Attached herewith as Exhibit B is a copy of the TARR status of Registration No.

3,137,789 for the service mark SMALL WORLD NET showing that the last known address of Registrant as 3008 Silverthorn Drive, Oakville, Ontario L6L 5N6. Thus, Petitioner has fulfilled its obligation to the newly amended 37 CFR §§ 2.111 (a) and (b).

Newly amended 37 CFR §§ 2.111 (a) and (b) state that “[I]f a service copy is returned to plaintiff as undeliverable, plaintiff must notify the Board within ten (10) days of receipt of the returned service copy, or of any notice indicating that the service copy could not be delivered.” Petitioner confirms that the service copy was returned to its attorneys’ office on January 14, 2008 - the date of filing this notice. Consequently, this filing is timely and is in accordance with the new amendments.

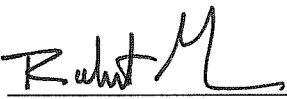
Pursuant to CFR §§ 2.111 (b), independent investigation has found the company to be registered to an address of 1122 Baltimore Place, Oakville, Ontario Canada L6J 2CP. Another corporate address of 47 Paper Mill Lane, Bedford, Nova Scotia B4A 3W5 has been used in Registrant’s Canadian trademark applications.

Wherefore, Petitioner hereby requests that this cancellation be sustained and that registration of SMALL WORLD NET, Registration No. 3,137,789 be cancelled.

Dated: Scarsdale, New York  
January 14, 2008

Respectfully submitted,

**LACKENBACH SIEGEL LLP**

By: 

Robert B. Golden  
Lackebach Siegel Building  
One Chase Road  
Scarsdale, New York 10583  
(914) 723-4300 phone  
(914) 723-4301 fax

*Attorneys for Petitioner*

# **EXHIBIT A**

**Lackebach**  
INTELLECTUAL PROPERTY  
ATTORNEYS SINCE 1923 **Siegel, LLP**

WRITER'S DIRECT DIAL  
(914) 723-4350x171  
nsaraco@LSLLP.com

January 2, 2008

Via Air Mail

Small World Net Corporation  
3008 Silverthorn Drive  
Oakville, Ontario L6L 5N6

*Re: aSmallWorld Ltd. v. Small World Net Corporation  
Cancellation of Registration No. 3,137,789 – SMALL WORLD NET*

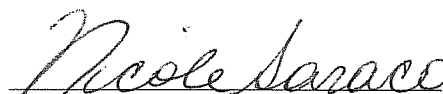
Dear Sir or Madam:

Pursuant to Rule 2.111(a), (b), and (c)(4) of the Trademark Trial and Appeal Board, enclosed herewith please find the Petition to Cancel the above-referenced trademark registration.

Thank you for your attention to this matter.

Very truly yours,

LACKENBACH SIEGEL, LLP



Nicole Saraco  
Paralegal

/ns

Enclosure

O:\1 Documents\SmallWorld Ltd\2008\Nicole\Small World Net Corporation\01.02 Letter to Registrant - Corporation.doc

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In re: Registration No.** 3,137,789  
**Trademark:** SMALL WORLD NET  
**International Class:** 35, 38, 42  
**Registration Date:** September 5, 2006

ASMAILWORLD LTD.	X	
	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No.:
	:	
SMALL WORLD NET CORPORATION,	:	
	:	
Registrant.	:	
	X	

**PETITION FOR CANCELLATION**

Petitioner, aSmallWorld Ltd. ("Petitioner"), a corporation duly organized and existing under the laws of the country of the United Kingdom, with offices at Eagle House, 110 Jermyn Street, London Sw1y 6RH, United Kingdom, believes that it is being damaged and that it will continue to be damaged by the continued registration on the Principal Register of U.S. Registration No. 3,137,789 for the mark SMALL WORLD NET, in International Classes 35, 38, and 42 by Small World Net Corporation.

As grounds for cancellation, Petitioner alleges:

1. Petitioner is a corporation duly organized and existing under the laws of the country of the United Kingdom, with offices at Eagle House, 110 Jermyn Street, London Sw1y 6rh, United Kingdom.

2. Petitioner is the owner of the following United States Trademark Applications (“Petitioner’s Applications”):

- a. United States Serial No. 78/717,338 for the trademark ASMALLWORLD filed on September 21, 2005 for use in connection with “Providing multiple-user access to a global computer information network of websites; access to electronic messaging systems, namely, providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; computer aided transmission of messages and images; electronic mail services in International Class 38; for use in connection with “Travel information services provided over the internet; providing links to web sites of others featuring travel; transportation information in the nature of travel and tour information provided over the internet” in International Class 39; and for use in connection with “Providing a website featuring information on and about special events and parties, recreation, points of interest, education, and booking of seats for shows; providing non-downloadable on-line publications in the nature of electronic books, magazines, journals and newsletters in the field of general interest; providing an online educational and entertainment electronic database featuring multi-user interactive computer games in the fields of sports, entertainment, politics and finance; entertainment services in the nature of online gaming services; entertainment services, namely, providing prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global

computer network; entertainment services, namely, provision of non-downloadable films via an online video-on-demand service” in International Class 41; and

- b. United States Serial No. 78/979,411 for the trademark ASMALLWORLD filed on September 21, 2005 for use in connection with “on-line advertising and marketing services; advertising via electronic media and specifically the internet; promoting the goods and services of others by distributing advertising materials through a variety of methods; provision of advertising space by electronic means and global information networks; providing and rental of advertising space on the internet; dissemination of advertising for others via the internet; commercial information services and advice for members, provided online via a computer network; providing consumer product information via the internet; marketing by compilation and display of a variety of goods and services, on behalf of others, to permit customers and users to acquire information on and purchase goods and services; business advice and information provided on-line via computer network; general business networking referral services, namely, promoting the goods and services of others by passing business leads, business contacts and referrals among group members; employment hiring, recruiting, placement, staffing and career networking services and information provided on-line via computer network; organizing business competitions on-line via computer networks for the purpose of advertising and sales promotion; computerized collection of



business information indices, namely, customer indexes; collection, preparation, composition, processing, acquisition and provision of business information in databases; management of computerized files” in International Class 35; for “providing information on insurance matters, financial services and real estate listings via the internet” in International Class 36; for “providing online reviews of restaurants and hotels” in International Class 43; and for “internet based dating services; providing information in the field of clothing rental online via computer network” in International Class 45, (collectively with the services in ¶2.a “Petitioner’s Services”).

3. Petitioner has used the mark ASMALLWORLD in interstate commerce since March 18, 2004 on or in connection with Petitioner’s Services.

4. Upon information and belief and according to the Patent and Trademark Office’s (“PTO”) records, Small World Net Corporation (“Registrant”) is a corporation duly organized and existing under the laws of the country of Canada with an address of 3008 Silverthorn Drive, Oakville, ON L6L 5N6.

5. Registrant is the record owner of the U.S. trademark mark registration for SMALL WORLD NET (“Registrant’s Mark”), Reg. No. 3,137,789, for use in connection with “Managing contact information between individuals or corporate customer service databases or departments to facilitate communication,” in International Class 35; for “telecommunications access services” in International Class 38, and for “providing non-downloadable software for use in managing contact information between individuals or corporate customer databases or departments to facilitate communication” in International Class 42 (“Registrant’s Registration”).

6. Upon information and belief and according to the PTO's records, Registrant's Mark was registered on the Principal Register on September 5, 2006.

7. Upon information and belief, Registrant has intentionally ceased all use of Registrant's Mark and Registrant has no intention to resume use of Registrant's Mark at any time in the future.

8. Upon information and belief, Registrant has intentionally abandoned Registrant's Mark as well as Registrant's Registration thereof.

9. In the prosecution of Petitioner's Application 78/717,338, the PTO has cited Registrant's Registration for Registrant's Mark as a bar to the registration of Petitioner's Application.

10. The registration and continued registration of Registrant's Mark has damaged, and will continue to damage, Petitioner as such registration may bar Petitioner's own use and registration of Petitioner's Application 78/717,338 for ASmallWorld in connection with Petitioner's Services, and further, continued registration provides Registrant with a means to interfere with Petitioner's efforts to promote and use Petitioner's Applications in commerce in connection with Petitioner's Services.

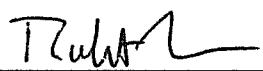
**WHEREFORE**, Petitioner believes that it is being damaged by the continued registration of Registration No. 3,137,789 for the trademark SMALL WORLD NET for Registrant's Goods in International Class 35, 38, and 42 and respectfully prays that Registrant's registration be canceled and stricken from the Principal Register.

**The Commissioner is hereby authorized to charge Petitioner's Attorneys' Deposit Account No. 100100 for the requisite opposition filing fee of \$900.00, required by 37 C.F.R. §§ 2.111 and 2.6, and to charge any additional fees which may be required or to credit any overpayments to the same deposit account.**

Dated: Scarsdale, New York  
January 2, 2008

Respectfully submitted,

**LACKENBACH SIEGEL LLP**

By:   
Robert B. Golden  
Lackebach Siegel Building  
One Chase Road  
Scarsdale, New York 10583  
(914) 723-4300 phone  
(914) 723-4301 fax

*Attorneys for Petitioner*

## CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the enclosed **PETITION FOR CANCELLATION** was served on Registrant on January 2, 2008 via Air Mail, addressed to Registrant as follows:

Small World Net Corporation  
3008 Silverthorn Drive  
Oakville, Ontario L6L 5N6

Dated: Scarsdale, New York  
January 2, 2008

  
Nicole Saraco

O:\1 Documents\SmallWorld Ltd2008\Nicole\Small World Net Corporation\Petition for Cancellation- Abandonment - Corporation.doc

AIR MAIL  
CORREO AEREO  
PAR AVION

**Lackebach  
Siegel, LLP**

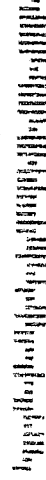
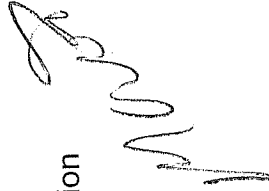
INTELLECTUAL PROPERTY  
ATTORNEYS SINCE 1923

LACKENBACH SIEGEL BUILDING • ONE CHASE ROAD • SCARSDALE, NEW YORK 10583 U.S.A.

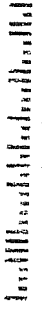
TO:

Small World Net Corporation  
3008 Silverthorn Drive  
Oakville Ontario L6L 5N6

~~CANADA~~



MOVED / UNKNOWN // DEMENAGE / INCONNU  
RETURN TO SENDER  
RENOU A L'EXPEDITEUR  
NY 10583  
USA



# **EXHIBIT B**

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2008-01-14 14:54:06 ET**

**Serial Number:** 78007170 Assignment Information      Trademark Document Retrieval

**Registration Number:** 3137789

**Mark (words only):** SMALL WORLD NET

**Standard Character claim:** No

**Current Status:** A cancellation proceeding has been filed at the Trademark Trial and Appeal Board and is now pending.

**Date of Status:** 2008-01-04

**Filing Date:** 2000-05-07

**Transformed into a National Application:** No

**Registration Date:** 2006-09-05

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 112

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2006-09-05

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#### LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. Small World Net Corporation

**Address:**

Small World Net Corporation  
3008 Silverthorn Drive  
Oakville, ONTARIO L6L 5N6  
Canada

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Canada

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#### GOODS AND/OR SERVICES

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**International Class:** 035

**Class Status:** Active

Managing contact information between individuals or corporate customer service databases or departments to facilitate communication

**Basis:** 44(e)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 038

**Class Status:** Active

Telecommunications access services

**Basis:** 44(e)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 042

**Class Status:** Active

Providing non-downloadable software for use in managing contact information between individuals or corporate customer databases or departments to facilitate communication

**Basis:** 44(e)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**Disclaimer:** "NET"

**Foreign Application Number:** 1035259

**Foreign Registration Number:** TMA567065

**Foreign Registration Date:** 2002-09-09

**Country:** Canada

**Foreign Filing Date:** 1999-11-12

**Foreign Expiration Date:** 2017-09-09

**Foreign Renewal Date:** 2017-09-09

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-01-04 - Cancellation Instituted No. 999999

2006-11-25 - TEAS Change Of Correspondence Received

2006-09-05 - Registered - Principal Register



2006-07-18 - 1(B) Basis Deleted; Proceed To Registration  
2006-07-18 - Notice of Allowance canceled  
2006-07-03 - TEAS Delete 1(B) Basis Received  
2006-06-13 - Notice of allowance - mailed  
2006-03-21 - Published for opposition  
2006-03-13 - TEAS Change Of Correspondence Received  
2006-03-01 - Notice of publication  
2006-02-06 - Law Office Publication Review Completed  
2006-02-06 - Assigned To LIE  
2006-01-19 - Approved for Pub - Principal Register (Initial exam)  
2006-01-05 - Teas/Email Correspondence Entered  
2005-12-06 - Communication received from applicant  
2005-12-06 - TEAS Response to Office Action Received  
2005-06-07 - Non-final action mailed  
2005-06-07 - Non-Final Action Written  
2004-11-24 - Report Completed Suspension Check Case Still Suspended  
2004-05-17 - LETTER OF SUSPENSION E-MAILED  
2004-03-16 - Case File In TICRS  
2001-05-16 - Unresponsive/Duplicate Paper Received  
2001-05-25 - Letter of suspension mailed  
2000-11-14 - Non-final action mailed  
2000-09-12 - Assigned To Examiner

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#### ATTORNEY/CORRESPONDENT INFORMATION

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**Correspondent**

Small World Net Corporation  
3008 Silverthorn Drive  
Oakville, ONTARIO, L6L 5N6 CANADA

Phone Number: 312-222-0800

Fax Number: 312-222-0818

**Domestic Representative**

Judith L. Grubner

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